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09/480,826

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Charles S. Taylor

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EXAMINER

BUI, VY Q

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/480,826	<b>Applicant(s)</b> TAYLOR ET AL.	
	<b>Examiner</b> Vy Q. Bui	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19-23 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) 4, 9-13, 15, 19-23 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 14, 16 and 27-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Election/Restrictions***

Applicant explicitly elected of the invention as shown in Fig. 33, species 15, claims 1-3, 5-8, 14, 16 without traverse in the reply filed on 10/20/20/2008 (page 2). Paper 10/22/2008 (page 2) also clearly admitted that claim 5 is generic to claim 9 and claim 14 is generic to claims 15 and 19. The Applicant did not assert that claims 9, 15 and 19 read on elected species as shown in Fig. 33. Therefore, withdrawal of claims 9, 15 and 19 from further consideration is proper. When the generic independent claims 5 and 14 are allowed, dependent claims 9, 15 and 19 will be rejoined.

***Telephone Interview***

Applicants requested a declaration of an interference between the current invention and U.S. Pat. No. 5,984,867 to Robert K. Deckman (paper 1/31/2000).

In a telephone interview between the Applicants and Primary Examiner Dawson in December 5, 2007 (paper 3/17/2007), Applicants stated that Applicants do not further maintain the intention to provoke an interference between the present invention and U.S. Pat. No. 5,984,867 to Robert K. Deckman. However, in the file record, Applicants offered no reasons as to why the claimed invention is now different from U.S. Pat. No. 5,984,867 to Robert K. Deckman.

In the previous response (paper 11/16/2009), the Applicants stated in the "Remarks" (page 7) that "the foot 102 of U.S. Pat. No. 5,984,867 is not rotatable relative to the frame or blade that it is coupled to, about an axis transverse to the first axis, as shown by Figs. 5 and 6 of

Art Unit: 3773

the patent". However, Figs. 5 and 6 of the patent clearly shows that foot 201 is rotated relative to frame 22 about an axis normal to the page of Figs. 5 and 6 and going through element 74.

In order to keep the record of the prosecution clear and complete, the Applicants are respectfully requested to provide in the next response to this "Office Action" the reason why the present claimed invention is no longer considered as an interference to U.S. Pat. No. 5,984,867 to Robert K. Deckman.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5 and 27-28, 30-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1, 2 and 4 of U.S. Patent No.

5,976,171 and over claims 5, 6, 8, claims 14-16 and claim 24 of U.S. Patent No. 7,288,065.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claimed invention and the above two patents all claim a (retractor) device

Art Unit: 3773

including a ratchet mechanism, and other main structural limitations, such as 1<sup>st</sup> arm, 2<sup>nd</sup> arm and two blades, for example. Please, notice that the claimed devices in the patents are indeed retractors.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation “an axis of movement of along said frame member” is not understood. Correction is requested.

Claims 2-3 dependent on claim 1 are also rejected for the same reason.

***Claim Rejections - 35 USC § 102/103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jensen-3,572,326.

1.1. As to claims 5-7, 8, Jensen-'326 (Fig. 1-2, 4) discloses a frame defined by elements 18 & 19 & 20 & 22 & 23 & 24 & 33 & 42, 1<sup>st</sup> blade/arm 49 coupled to frame element 42 and 2<sup>nd</sup> opposed blade/arm 47 coupled to the frame element 33, 2<sup>nd</sup> blade movable toward or

Art Unit: 3773

away 1<sup>st</sup> blade along 1<sup>st</sup> lateral axis defined by arm 47, hexagonal head of arm 47 as an actuator for moving 2<sup>nd</sup> blade toward or away from 1<sup>st</sup> blade, wherein hexagonal head of arm 47 can be rotated and push or pull to convert a rotational movement to a translational driving force as recited in claim 5, foot 48 rotatably coupled to frame element 33 via coupling 56 and coupling 56 locks or free a relative rotation between foot 48 and frame element 33 as recited in the claim. Please notice that for claim 5, coupling 56 (F. 1, 4) meets the limitation “said coupling permitting rotation of said foot with respect to said at least one of the frame and first and second blades in one direction, and preventing rotation of said foot with respect to said at least one of said frame and the first and second blades in an opposite direction”, because when coupling 56 is in an unlock condition, at least one can rotate foot 48 in one direction, and then lock the rotation by coupling 56 to prevent rotation of foot 48 at least in an opposite direction. Notice that claim 5 only requires that coupling 56 is capable of allowing a rotation of foot 48 in one direction and locking foot 48 of rotation in an opposite direction.

1.2. Alternatively, as to claims 5 and 8, F. 1 of Jensen-‘326 shows frame/elongate bar 33, 1<sup>st</sup> blade/arm 46 and 2<sup>nd</sup> opposed blade/arm 47 being mounted to the elongate 33 by rotatable connector 56, hexagonal head of arm 46 as an actuator for moving 2<sup>nd</sup> blade toward or away from 1<sup>st</sup> blade along 1<sup>st</sup> axis defined by elongate bar 33, foot 48 rotatably coupled to frame element/elongate bar 33 via coupling 56 and coupling 56 locks or frees a relative rotation between foot 48 and frame element/elongate bar 33 as recited in the claim

1.3. As to claim 6, foot 48 is linearly movable to frame element 33 along an axis defined by arm 48.

1.4. As to claims 5-8, notice that 1<sup>st</sup> blade 49 and 2<sup>nd</sup> blade 47 each includes a curved section/arcuate throat and a tip section/elongated vane section. Please, see 1<sup>st</sup> blade

Art Unit: 3773

(connecting to arm 49) having a curved-hand shaped with curved section and 4 fingers/vanes as shown in F. 1 of Jensen-'326.

1.5. Alternatively, it would have been obvious to one of ordinary skill in the art to provide a retractor blade with a curved section/arcuate throat and vanes/extended tip sections as recited in the claims as this configuration would provide the blade to function as a hook to receive and keep the rib in place during a surgery procedure. It is well within level of an ordinary skill in the art to provide the blade as recited in the claims as this configuration of the blade involves only minor modification or design of a common used blade in the art.

In another alternative, it is well known to configure a rib retractor to have an elongate vane and a curved throat to receive and keep a rib in place during a surgery operation. For example, a blade as shown in F. 6 of Forder-4,344,420 includes arcuate throat and elongated vane substantially as recited in the claims. In view of Forder-'420, it would have been obvious to one of ordinary skill in the art to configure Jensen-'326 blade to have an arcuate throat and elongated vane as recited in the claims.

1.6. As to claim 14, Jensen-'326 (Fig. 1-2, 4) discloses elongate member 33, 1<sup>st</sup> arm/blade 49, 2<sup>nd</sup> arm/blade combination 47 having hexagonal head 67 (F 3) as an actuator, element 60/61 as a drive member, and elements 64/65/66 and 58/59/60 as a drive mechanism, to drive said 2<sup>nd</sup> blade toward or from 1<sup>st</sup> blade, shoe 48 having element 55 with a support surface to engage a patient's chest, locking member 56 or 64 (Fig. 4) allowing or locking a rotation between 2<sup>nd</sup> blade and elongate member 33 substantially as recited in the claim. Please notice that when element 35 is positioned at a position higher than that of element 34, one can translate locking member 56 together with 2<sup>nd</sup> arm/blade 47 away from 1<sup>st</sup> arm/blade 49 toward element 35 to rotate said 2<sup>nd</sup> arm/blade 47 relative to elongate member 33 and lift a rib because in an unlocking condition, locking member 56 (F. 4) allows a rotation as well as a

Art Unit: 3773

translation of 2<sup>nd</sup> arm/blade 47 relative to elongate member 33. Therefore, at least Jensen-'326 device is capable of performing the function as recited in the claims.

1.7. As to claim 16, shoe 48 is coupled to 2<sup>nd</sup> blade 47 via elongate locking member 56 and elongate member 33. A rotation of elongate 33 will rotate shoe 48 and 2<sup>nd</sup> blade 47 together.

1.8. As to claim 29, Jensen-'326 (Fig. 1-2, 4) discloses frame / elongate member 33, 1<sup>st</sup> arm/blade 49, 2<sup>nd</sup> arm/blade combination 47 having hexagonal head 67 (F 3) as an actuator, element 60/61 as a drive member, and elements 64/65/66 and 58/59/60 as a drive mechanism, to drive said 2<sup>nd</sup> blade toward or from 1<sup>st</sup> blade, shoe / foot 48 having element 55 with a support surface to engage a patient's chest, locking member 56 or 64 (Fig. 4) allowing or locking a rotation between 2<sup>nd</sup> blade and elongate member 33, foot 48 having a coupling 56 (F 3) substantially as recited in the claim.

### ***Allowable Subject Matter***

Claims 27, 28, 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 5/11/2009 have been fully considered but they are moot in view of the rejection as indicated above.



Art Unit: 3773

***Response to Amendment***

The amendment of independent claim 1 on 5/11/2009 under 37 CFR 1.131 has been carefully considered but is ineffective to overcome the prior art reference as indicated in the above rejection.

The same prior arts of reference are also applicable to reject the claims as indicated in the above rejection.

***Conclusion***

This is a RCE of applicant's earlier Application No. 09/480,826. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 3773

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vy Q. Bui/  
Primary Examiner, Art Unit 3773